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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/542,095 10/12/95 DELABASTITA

P GV-2166

EXAMINER
ANGEDRANDE, J. M.

11M1/0614

RICHARD J BIRCH
SUITE 125
20 WILLIAM STREET
WELLESLEY MA 02181

ART UNIT PAPER NUMBER

1113

DATE MAILED: 06/14/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/12/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-7 are pending in the application.
Of the above, claims — are withdrawn from consideration.
- ☐ Claims — have been cancelled.
- ☐ Claims — are allowed.
- ☒ Claims 1-7 are rejected.
- ☐ Claims — are objected to.
- ☐ Claims — are subject to restriction or election requirement.
- ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on —. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on —, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed —, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. —; filed on —.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

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15 the response provided by the applicant has been read and given careful consideration. The objections to the specification are withdrawn in view of the amendments made. Responses to the arguments raised by the applicants are provided after the rejection they are directed to. The specification should be amended to insert --, now abandoned-- after the reference to the parent application.

16 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

17 Claims 1-6 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-8 of copending application Serial No. 08/542094. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The only difference is in the substitution of "scan-wise exposing" in the instant claims in place of "image-wise exposing".

The applicant stated in the parent application that terminal disclaimer will be filed. A terminal disclaimer has not yet been filed in the instant application, therefore this rejection and the one in paragraph 19 below are maintained.

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18 Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending application Serial No. 08/542094 in view of Saikawa et al. '811 or Peterson '762.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Saikawa et al. '811 teaches the use of a laser or LED to expose a diffusion transfer which is developed using an alkaline processing solution. Examples of light sources are disclosed. col 1/lines 60-63, hereinafter 1/60-63, 2/32-42 and 2/55-65)

Peterson '762 establishes that it is known to use a laser to form a lithographic printing plate. The process uses a mixture of a diazo composition with nitrocellulose and carbon black. The carbon black absorbs light converting it heat and heating the nitrocellulose until it combusts, removing it from the support surface. The formation of letterpress printing plates is also disclosed.

It would have been obvious to use lasers or LEDs to expose the materials claimed in co-pending application 08/227073, based upon the teachings within the art to expose materials specifically forming lithographic printing plates, such as those provided by Saikawa et al. '811 or Peterson '762.

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See the above paragraph for a response.

19 The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

20 The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

21 Claims 1,4,6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over either Saikawa et al. '811 or Monbaliu et al. '156, in view of Stoffel et al. (1981).

Monbaliu et al. '156 teaches the use of conventional sources, laser or LEDs for exposing silver diffusion media to form lithographic printing plates. (col 10/line 66-col 11/line

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35, hereinafter 10/66-11/35). The processing is described in the abstract and claims as well as the text.

Stoffel et al. '(1981) teaches various techniques for use in scanning and screening images such as photographs and camera images to produce halftone images which are useful with binary output devices such as lithography. (Page 1898/col 1/paragraphs 1-2). Pages 1907,1908,1915,1916 and tables I & II describe the process of error diffusion and the benefits.

It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by either Saikawa et al. '811 or Monbaliu et al. '156 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithography.

The applicant argues that apart from the fact that lithography covers the computer-to-plate techniques, the use of it with frequency modulation is new and inventive. The applicant admits that Stoffel et al. specifically states that the use of the algorithms described are compatible with lithography, although optimization is not specifically discussed with respect to each. The examiner holds this to support his position, not that of the applicant. Further the penultimate statement cited

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only points out to one of ordinary skill in the art that proper registration is necessary to avoid tone scale errors. The applicant does not exclude this registration process and it is generally recognized to be important in constructing multicolor images by those in the printing industry. Also the passage cited earlier by the applicant makes it clear that this is an overview and some optimization is required for each process it can be used with for it to reach its full potential. The examiner holds that this does not point away from the invention, but reminds one of ordinary skill in the art that these techniques are particularly registration sensitive. The examiner notes that passages cited by the applicant specifically point out the described techniques are general to the processes that they are taught as useful with and not directed to any particular process. The examiner maintains the rejection for the above reasons.

The applicant did not send the citations as indicated in the preamendment filed October 12, 1995. The applicant argues that neither of Saikawa et al. '811 or Monbaliu et al. '156 teach the use of screened data as the output of the laser exposure pattern and argues that both Saikawa et al. '811 and Monbaliu et al. '156 are non-analogous to Stoffel et al. '(1981). The examiner notes these arguments and points out that the output of the lasers are controlled by digital data to produce the image and therefore must have some connection to a controlling means for performing

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the exposure in an imagewise manner. Neither Saikawa et al. '811 or Monbaliu et al. '156 teach using a physical masking element with the laser exposure process. Secondly, the first portion, ie the scanning of the image and screening of the data is fully disclosed by Stoffel et al. '(1981) as is its use in "lithography" set forth on page 1898 column 1, paragraph 2, line 3. The same terminology is used by both Saikawa et al. '811 and Monbaliu et al. '156 in thier abstracts, therefore establishing a linkage between the arts and motivation to combine the teachings of Stoffel et al. '(1981) with those of the lithographic arts, including Saikawa et al. '811 and Monbaliu et al. '156. Additionally, the use of lithography as an binary output device is disclosed by Stoffel et al. Clearly, the laser exposure processes of both Saikawa et al. '811 and Monbaliu et al. '156 represent output devices. The examiner has reiled upon the secondry reference to provide the motivation for the combination of these references. In Heidelberger Druckmaschinen A.G. v. Hantscho Commercial products the fields of endeavor are clearly different relating to printing presses, sheet metal working and compressors. No such divergence exists here all of the art is directed to producing images. Therefore, this citation is neither as relevent or persuasive as the applicant would have it be. As set forth in the above citation on page 1377, "whether a reference is 'analogeous art' is a question of fact". With

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respect to In re Geiger, the basis of obviousness of the combination of ingredients from three different references was at issue and from the passage in the second column of page 1278, it appears that no direction was provided to the other components. In the instant application ample direction is found within Stoffel et al., which directs on to the lithographic arts. While it does not specifically mention the complete recitation of the remaining portions of the claims, when doing so the examiner holds that one of ordinary skill in the art would be directed to lithographic printing plates and thier manufacture based upon the teachings of the binary marking/display technologies section as well as the citation of "printing technologies-**lithography**, ..." within that section. As the only way in which lithographic printing may be preformed is with a lithographic printing plate, the examiner holds that one of ordinary skill in the art would immediately recognize that this reference does direct one of ordinary skill in the art to the formation of lithographic printing plates as direct writing of the image onto the final page does not constitute lithography. The rejection is therefore maintained for these reasons.

22 Claims 1,4,5 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Peterson '762, in view of Stoffel et al. '(1981).

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It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by Peterson '762 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithographic, letterpress and gravure printing.

See the response provided in paragraph 21 above. The examiner also directs the applicant to the teachings of relief printing in the binary marking/display technologies section as well as the citation of "printing technologies-lithography, Letterpress and gravure ..." within the halftone imagery section.

23 This is a continuation of applicant's earlier application S.N. 08/227073. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

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ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


24 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebranndt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-2303.

Facsimile correspondence should be directed to (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Martin J. Angebranndt
Patent Examiner, Group 1100
June 14, 1996